

**REMARKS****Summary of the Office Action**

Claims 1-7 are rejected under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

Claims 1, 2, and 4-9 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 1,124,375 to Wood ("Wood").

Claim 3 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Wood in view of U.S. Patent No. 6,219,503 to Miyake et al. ("Miyake").

**Summary of the Response to the Office Action**

Claims 1-9 are presently pending for further consideration. Claims 1 and 4 have been amended to overcome the rejections under 35 U.S.C. § 112, second paragraph.

**Rejection Under 35 U.S.C. § 112, Second Paragraph**

Claims 1-7 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant respectfully traverses the rejection.

In referring to the phrase "the sheets are bound by the clincher's folding leg portions of the staple," the Office Action states that "[i]t is difficult to discern whether the clincher or the staple has the folding leg portions." Applicant is unsure as to how the phrase can be interpreted in any other way than that the clincher performs the act of folding leg portions of the staple. Folding the leg portions of staples to bind sheets is the purpose of a clincher. The possessive "clincher's" is used because the following word "folding" is a gerund, which is properly

preceded by a possessive noun. Nevertheless, the word “of” has been inserted between “folding” and “leg portions” in the phrase of claims 1 and 4 to ensure that others will not misinterpret the phrase.

**Rejection Under 35 U.S.C. § 102(b)**

Claims 1, 2, and 4-9 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Wood. Applicant respectfully traverses the rejection of claims 1, 2, and 4-9.

The “Response to Arguments” section of the Office Action states that “Applicant contends that the receiving heads and spring clips of Wood cannot form the recess portions because the receiving heads and spring clips of Wood are not located on the driver and are not contiguous to the staple injecting port.” The Office Action then addresses whether the recess grooves are contiguous to the staple injecting port, but does not address at all the fact that the receiving heads and spring clips of Wood are not located on the driver unit.

Assuming for the sake of argument that the receiving heads and spring clips of Wood are contiguous to a staple injecting port, they are still not located on the driver as clearly recited for the recess grooves of claims 1, 4, and 6. While claim 1 has been amended to further emphasize the requirement that the recess grooves are located on the driver unit, claims 4 and 6 have always recited “recess grooves formed on the driver unit.” Even if the receiving heads and spring clips of Wood are assumed to be “recess grooves,” they are not “on the driver unit” as clearly recited in claims 1, 4, and 6.

For at least the above reasons, Applicant respectfully requests that the rejection of claims 1, 2, and 4-9 under 35 U.S.C. § 102(b) as being anticipated by Wood be withdrawn.

The Office Action alleges that “the staple injecting port 31 and the recess grooves (between 22 and 23) are connected by the links and connections shown in Fig. 1. Therefore, the grooves are deemed to move integrally with the staple injecting port.” However, in Wood, there are at least two conditions. In a first condition, shown in Fig. 1, the staple injecting port 31 comes close to the alleged recess grooves (between 22 and 23). In a second condition, shown in Fig. 4, the staple injecting port 31 comes close to the alleged recess grooves (between 22 and 23). That is, the staple injecting port 31 and the alleged recess grooves (between 22 and 23) are relatively moved, and movements of the staple injecting port 31 and the alleged recess grooves (between 22 and 23) are independent of each other. Therefore, in Wood, the staple injecting port 31 and the alleged recess grooves (between 22 and 23) do not integrally move as recited in claims 8 and 9. For at least this additional reason, Applicant respectfully requests that the rejection of claims 8 and 9 under 35 U.S.C. § 102(b) as being anticipated by Wood be withdrawn.

**Rejection Under 35 U.S.C. § 103(a)**

Claim 3 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Wood in view of Miyake et al. A copy of the Priority Document JP 2002-188883, filed on June 28, 2002 during the international stage of the PCT Application, and an English translation of that priority document were attached to the previous amendment to overcome the previously cited reference (Suzuki). The Office Action states that “the English translation of the Priority document JP 2002-188883 filed with applicant’s amendment on May 31<sup>st</sup>, 2007 is new evidence that necessitates a new grounds of rejection.” Applicant respectfully disagrees. Please note that the certified priority document was filed with the application on December 27, 2004 – long before

the Office Action of March 7, 2007 which cited the Suzuki reference. As clearly explained in 37 C.F.R. § 1.55(a)(4)(i), “[a]n English translation of a non-English language foreign application is not required except ... (B) When necessary to overcome the date of a reference relied upon by the examiner.” Thus, the Examiner was on notice of the priority date before the rejection that led to the filing of the certified translation of the priority document and thus the priority document cannot be considered “new evidence that necessitates a new ground[] of rejection.”

In any event, Applicant respectfully asserts that claim 3 is in condition for allowance based on its dependence from claim 1.

Applicant respectfully asserts that independent claims 1, 4, and 6; and their dependent claims 2, 3, 5, and 7-9 are in condition for allowance.

**CONCLUSION**

It is respectfully submitted that all claims are now in condition for allowance, early notice of which would be appreciated. **Should the Examiner disagree, Applicant respectfully requests a telephonic or in-person interview with the undersigned attorney to discuss any remaining issues and to expedite the eventual allowance of the claims.**

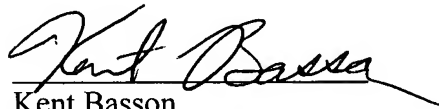
If there are any other fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 50-0310. If a fee is required for an extension of time under 37 C.F.R. § 1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,

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Dated: November 5, 2007

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